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In re Application of	:	DECISION ON
Ian P. Murray	:	
PCT No.: PCT/US2004/002497	:	
Application No.: 10/544,091	:	
Int. Filing Date: 29 January 2004	:	PETITION UNDER
Priority Date: 31 January 2003	:	
Attorney's Docket No.: 103376.0005	:	
For: MULTI-AXIAL POSITIONING...	:	
CONTAINER	:	37 CFR 1.47(b)

This decision is in response to applicant's "STATEMENT OF FACTS IN SUPPORT OF FILING ON BEHALF OF EXECUTING INVENTOR," which is being treated as a petition under 37 CFR 1.47(b) submitted on 11 September 2006 that seeks the acceptance of the application without the signature of the inventor Ian P. Murray. Petitioner has been charged the petition of \$200.00 under 37 CFR 1.17(g) to the Deposit Account No. 50-1752.

BACKGROUND

On 29 January 2004, applicant filed international application PCT/US2004/002497, which claimed priority of an earlier application filed 31 January 2003.

On 29 July 2005, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c)(1). However, no executed declaration or oath was submitted at such time.

On 08 March 2006, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 indicating that "the oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. The notification set two months from the date of this notice or 32 months from the priority date for the application, whichever is later. Failure to properly respond will result in abandonment."

In an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4), applicant filed on 11 September 2006, the following:

- 1) a petition under 37 CFR 1.47(b);
- 2) an unexecuted Declaration;

3) Declaration by Trish Paramore;

4) the required petition fee.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Applicant has satisfied items (1), and (3), and but not items (2) and (4) - (6) thus not completing the requirements under 37 CFR 1.47(b).

Applicant has satisfied item (1) since the petition fee has been charged to the Deposit Account.

Regarding item (2), the averments of Ms. Paramore are not sufficient to support a finding that the nonsigning inventor, Mr. Murray refuses to sign because he was given a short time period (a little over two weeks) to review the documents and to mail them back. This was not enough time to make a determination because it could be that he was on vacation or out of town during the delivery attempts. In addition, no documentary evidence to support this assertion has been provided such as the mail or postal receipt of the documents being delivered.

Regarding item (3), applicant has stated the last known address of the inventor:

Ian Murray
3314 Paper Mill Road
Suite 201
Phoenix, MD 21131

Regarding item (4) a declaration has not been provided executed by an appropriate officer of company on behalf of the non-signing sole inventor, Mr. Murray.

Regarding item (6) applicant has not presented an adequate showing that the granting of this petition is necessary to preserve the rights of the parties or to prevent irreparable damage.

Regarding item (5) applicant has not submitted proof that applicant has sufficient proprietary interest in the application. Ms. Paramore's statement is not sufficient without corroborating evidence since there is no copy of the assignment (signed assignment by inventor Mr. Murray) has been provided with this petition.

If the application has been assigned, a copy of the assignment (in the English language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant prior to the date the application is deposited in the Patent and Trademark Office.

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by affidavit or declaration that those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by the affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter.

A proprietary interest obtained otherwise than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record. Note MPEP 409.03(f)

Accordingly, it is not appropriate to accord the national stage application status under 37 CFR 1.47(b) at this time.

CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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